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IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE

Patent No. : 7,112,598  
Issue Date : September 26, 2006  
Serial No. : 10/509,549  
Applicants : Maki TOKAI et al.  
Filed : September 28, 2004  
For : KAPPA-OPIOID AGONIST  
COMPRISING 2-PHENYL-  
BENXOTHAZOLINE DERIVATIVE  
Art Unit : 1626  
Examiner : Fiona POWERS  
Docket No. : 04661/HG  
Customer No.: 01933  
Confirm. No.: 5902

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MAIL STOP PETITIONS  
Commissioner for Patents,  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Dorothy DeFrancesco*  
Dorothy DeFrancesco

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Paper to Account No. 06-1378.

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING  
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MAIL STOP PETITIONS**

S I R :

1. This is a request for reconsideration of the patent term  
adjustment of zero days indicated in the above-identified issued  
patent. It is respectfully requested that applicants be afforded  
a patent term adjustment of 77 days.

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2. This application for patent term adjustment is being filed within two months of the issue date (37 CFR §1.705(d)).

3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))."

4. The above-identified patent is not subject to a terminal disclaimer (37 CFR §1.705(b)(2)(iii)).

5. As to any circumstances during the prosecution of this patent constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent application as set forth in §1.704 (37 CFR §1.705(b)(2)(iv)): there were none (37 CFR §1.705(b)(2)(iv)(B)).

6. The fee set forth in §1.18(e) (\$200), required by 37 CFR §1.705(b)(1), is paid as follows:  
Attached is a Form PTO-2038 in the amount of \$200.



To the extent not tendered by Form PTO-2038 attached hereto, authorization is given to charge any additional fees to Deposit Account No. 06-1378.

It is respectfully requested that this application for patent term adjustment be granted and that a Certificate of Correction be issued to indicate a patent term adjustment of 77 days.

Respectfully submitted,

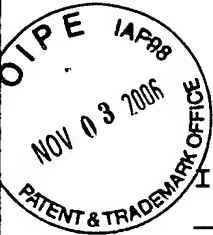
A handwritten signature in black ink, appearing to read "Richard S. Barth". The signature is written in a cursive style with a large, looped "B" at the end.

RICHARD S. BARTH  
REG. NO. 28,180

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RSB/ddf

Encs.: (1) Statement of the Correct Patent Term Adjustment:  
Basis Under §1.702 For the Adjustment (37 CFR §1.705  
(b)(2)(i) and (ii))

(2) Form PTO-2038



**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

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connection with this Paper to  
Account No. 06-1378.

**STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:  
BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT  
(37 CFR §1.705(b)(2)(i) AND (ii))**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MAIL STOP PETITIONS**

S I R :

1. This statement is being submitted in support of the  
"APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR  
RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED  
PATENT (37 CFR §1.705(d))" to which this statement is attached.

**37 CFR §1.705(b)(2)(i)**

2. The patent term adjustment indicated in the above-identified patent is zero days. It is respectfully submitted that such indication of patent term adjustment is in error, due to the improper inclusion of a 120 day applicant delay with respect to the filing in the USPTO of a paper on May 19, 2006, said paper being entitled "COMMENTS ON NOTICE OF ALLOWANCE."

It is respectfully submitted that the correct patent term adjustment under 37 CFR §1.702 is 77 days.

**37 CFR §1.705(b)(2)(ii)**

3. The basis on which applicants seek adjustment are as follows.

a. The Determination of Patent Term Adjustment Under 35 U.S.C. 154(b) attached to the August 15, 2006 Notice of Allowance indicated a patent term adjustment of 77 days.

b. The Notice of Allowability mailed on August 15, 2006 included an EXAMINER'S AMENDMENT. The EXAMINER'S AMENDMENT contained an error by referring to claim 11, rather than claim 8.

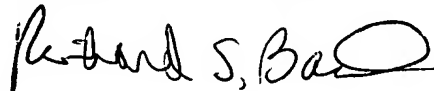
c. A paper was mailed to the USPTO by the applicants on May 15, 2006 entitled "COMMENTS ON NOTICE OF ALLOWANCE," wherein the aforesaid error in the EXAMINER'S AMENDMENT was noted, and correction of such error was requested.

d. The Patent Term Adjustment History on the USPTO website (a copy of which is enclosed) erroneously referred to the aforesaid May 19, 2006 paper as an "Amendment after Notice of Allowance (Rule 312)," and an applicants' delay of 120 days was erroneously assessed. The erroneous 120 day applicants' delay resulted in the patent term adjustment being changed from the aforesaid 77 days to zero days.

e. It is respectfully submitted that the filing of the aforesaid paper entitled "COMMENTS ON NOTICE OF ALLOWANCE" served to correct a USPTO error and was not a "failure to engage" and thus should not result in an applicants' delay.

f. It is further noted that the Examiner issued a Supplemental Notice of Allowability on June 7, 2006, which included a corrected EXAMINER'S AMENDMENT. Even assuming *arguendo* that the aforesaid May 19, 2006 paper would give rise to an applicants' delay, the delay would have ended on June 7, 2006, and thus would not have been a 120 day delay (35 CFR 1.740(c)(10)(i)).

Respectfully submitted,

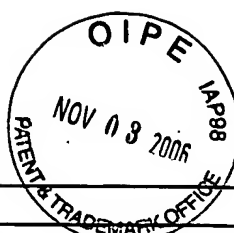


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RSB/ddf

Enclosure: copy of Patent Term Adjustment History from USPTO website

Search results as of: 10-19-2006::20:16:53 E.T.

**Patent Term Adjustment**

Filing or 371(c) Date:	09-28-2004	USPTO Delay (PTO) Delay (days):	77
Issue Date of Patent:	09-26-2006	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	120
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	0
USPTO Adjustment(days):	+0	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
09-26-2006	Patent Issue Date Used in PTA Calculation		
08-23-2006	Dispatch to FDC		
08-23-2006	Application Is Considered Ready for Issue		
08-23-2006	Response to Amendment under Rule 312		
08-07-2006	Issue Fee Payment Verified		
08-07-2006	Issue Fee Payment Received		
05-19-2006	Response to Reasons for Allowance		
06-07-2006	Mail Examiner's Amendment		
06-05-2006	Examiner's Amendment Communication		
05-19-2006	Amendment after Notice of Allowance (Rule 312)		120
05-15-2006	Mail Notice of Allowance		↑
05-15-2006	Mail Examiner's Amendment		↑
05-12-2006	Notice of Allowance Data Verification Completed		↑
05-12-2006	Examiner's Amendment Communication		↑
05-10-2006	Examiner Interview Summary Record (PTOL - 413)		↑
05-09-2006	Date Forwarded to Examiner		↑
05-02-2006	Response after Non-Final Action		↑
02-13-2006	Mail Non-Final Rejection	77	
02-08-2006	Non-Final Rejection	↑	
12-17-2004	Information Disclosure Statement considered	↑	
09-28-2005	IFW TSS Processing by Tech Center Complete	↑	
09-28-2005	Case Docketed to Examiner in GAU	↑	
06-28-2005	Corrected filing receipt	↑	
12-17-2004	Reference capture on IDS	↑	
12-17-2004	Information Disclosure Statement (IDS) Filed	↑	
09-28-2004	Request for Foreign Priority (Priority Papers May Be Included)	↑	
09-28-2004	Preliminary Amendment	↑	
05-04-2005	Correspondence Address Change	↑	
02-15-2005	Cleared by OIPE CSR	↑	
02-15-2005	Cleared by OIPE CSR	↑	
02-15-2005	Cleared by OIPE CSR	↑	
09-28-2004	371 Completion Date	↑	

02-08-2005	Application Dispatched from OIPE	↑
02-08-2005	Notice of DO/EO Acceptance Mailed	↑
09-28-2004	Initial Exam Team nn	↑

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